REMARKS

35 USC § 112, 1st Paragraph, Enablement

Claims 27, 28 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The rejections contend that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, the Examiner contends that the specification does not enable identifying a test subject as a candidate for having or being predisposed to heart failure or cardiac hypertrophy if it is observed that comparison of the individual's level of a zinc finger protein mRNA expression in blood is significantly higher than the level of expression in healthy control subjects. The Examiner further contends that the the generic term "zinc finger protein" encompasses a broad family of molecules and that it is highly unpredictable, of all the possible proteins that are "zinc finger proteins" to know which ones would be predictive of or indicative of cardiac hypertrophy or cardiac failure.

Applicant respectfully traverses the rejections. Nevertheless, in order to expedite prosecution of the application, Applicant has canceled claims 27–29, thereby rendering the rejections moot. Concomitantly with canceling these claims, Applicant has now filed claims 44 and 59, and claims depending therefrom.

The rejected claims relate to a method of identifying a test subject as a candidate for having or being predisposed to a specific disease if the individual's level of expression of a zinc finger protein gene in blood is significantly higher than in healthy subjects. In contrast, the instantly filed claims simply relate to a method of profiling gene expression or characterizing a body state in a human subject which is performed by determining levels of RNA encoded by each gene of a specific and unpredictable set of genes for gene expression profiling in blood, where the set of genes does not recite the generic term "zinc finger protein" but rather includes recitations of specific zinc finger protein genes.

Applicant has demonstrated that the instant claims have an enabled utility for

identification of potential markers of disease in the declarations dated 3/16/06 and 12/18/06, as graciously indicated by the Examiner in the Office Action dated 03/13/2009 regarding US Patent Application No. 10/268,730 of which the present application is a Division, and in view of the claims of the latter application and of the instant claims being limited to an identical set of genes. Attached is a copy of the above referenced declaration dated March of 2006. A copy of the above referenced declaration dated December 2006 was filed in this application on October 13, 2009.

In light of these claim amendments, Applicant respectfully submits that the instant claims satisfy the enablement requirements of 35 U.S.C. § 112, 1st paragraph.

Conclusion

Applicant further submits that all claims are allowable as written and respectfully requests early favorable action by the Examiner. If the Examiner believes that a telephone conversation with Applicant's attorney/agent would expedite prosecution of this application, the Examiner is cordially invited to call the undersigned attorney/agent of record. Should any fees be required to ensure consideration of this response, the Commissioner is authorized to charge Deposit Account 04-1105, Reference No. 2053B(204231).

Respectfully submitted,

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